

REMARKS

I. Status of the Claims

Claims 1-33, 38-82, and 87-102 are pending in this application and stand rejected. No claim has been amended or canceled in this paper.

II. Rejection under 35 U.S.C. § 103(a)

The Examiner maintains the rejection of claims 1-33, 38-82, and 87-102 under 35 U.S.C. § 103(a) “as being unpatentable over Blankenburg et al. (WO/99/04750 translation) (“Blankenburg”) in view of Firstenberg et al. (USPN5297566)” (“Firstenberg”), “for the reasons set forth in the Office Action dated February 8, 2005.” Final Office Action at 2. In particular, the Examiner asserts that Blankenburg teaches “the use of polymers containing polysiloxanes for hair cosmetic formulations,” and more specifically that “[a] water-dispersible polymer comprising ethylenically unsaturated monomers and polyalkylene oxide containing silicone derivatives.” Office Action dated Feb. 8, 2005. at 2-3. According to the Examiner, Blankenburg is deficient only in that it “lacks polyvinylpyrrolidone/vinyl acetate/vinyl propionate terpolymers, preferred cosmetic mediums, and preferred percent weight.” *Id.* at 3.

The Examiner cites Firstenberg, in an attempt to cure the deficiencies of Blankenburg, asserting that Firstenberg “teaches an aerosol device comprising a container containing an aerosol composition, comprising a liquid phase containing at least one film-forming polymer in a solvent and a gas phase.” *Id.* (citing Firstenberg at col. 1, lines 44-62; Examples 1-16). The Examiner continues by stating that “[v]inylpyrrolidone/vinyl acetate/vinyl propionate copolymer is taught and exemplified as

a film forming and hair setting polymer useful in the invention disclosed by Firstenberg.”

Id. at 3-4 (citing Firstenberg at col. 2, lines 41-56; Example 9). The Examiner concludes that:

[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to add the vinylpyrrolidone/vinyl acetate/vinyl propionate copolymer of Firstenberg et al. to the hair fixative composition of Blankenburg et al. because (1) Blankenburg and Firstenberg et al. both teach hair care fixative compositions in the for[m] of sprays; (2) Firstenberg et al. teaches vinylpyrrolidone/vinyl acetate/vinyl propionate copolymers as form filming polymers useful for setting hair; (3) Blankenburg et al. teaches that vinyl lactam homo and copolymers are known in the art as synthetic polymers that have been used for almost 50 years to strengthen hairdos . .

Id. at 4. Thus, the Examiner contends that “[o]ne would have been motivated to add the hair setting polymer vinylpyrrolidone/vinyl acetate/vinyl propionate copolymer of Firstenberg et al. to the composition of Blankenburg et al. because of an expectation of similar success in preparing a hair setting composition.” *Id.*

Applicant respectfully disagrees with the Examiner and traverses the rejection.

The Examiner has failed to establish a prima facie showing of obviousness for at least the following reasons. In order to establish a prima facie case of obviousness, the Examiner must, among other things, point to a suggestion or motivation within the references to modify or to combine reference teachings. See M.P.E.P. § 2143. The Examiner has not shown that the cited references provide the requisite teaching or suggestion that would motivate their combination.

The Examiner contends that “(4) Blankenburg et al. teaches [sic] that other cosmetic agents can be added to his composition; and (5) Firstenberg et al. teaches

that that more than one hair setting polymer may be used in a hair setting composition.” Office Action dated Feb. 8, 2005, at 4. Applicant respectfully points out that the standard is not whether the references can be combined or modified -- this “does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680 (Fed Cir. 1990)). The suggestion or motivation “must be found in the prior art reference, not in the Applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

In reality, not one of the 16 Examples of Firstenberg shows a composition with more than one film-forming polymer, notably this includes Example 9, which the Examiner relies upon for teaching and providing motivation for the combination of vinylpyrrolidone/vinyl acetate/vinyl propionate copolymers, with another film-forming polymer. Further, the crux of the teaching of Firstenberg is a method and device for styling the hair, wherein the spray is applied at a certain force, or mass flow, over time. Accordingly, the disclosure teaches more about the mechanical properties of its invention, than about the components of the composition used in the method and device.

Moreover, in its discussion of the prior art uses of synthetic polymers for hairstyling, Blankenburg states that “[a]t first, vinyl lactam homopolymers and copolymers were preferred, **but subsequently polymers containing carboxylate groups have become increasingly important.**” Blankenburg translation at page 1 (emphasis added). Such a statement at the very beginning of Blankenburg’s disclosure indicates that the invention of Blankenburg is a departure from, and alternative to, vinyl

lactam copolymers. The Examiner attempts to rebut this argument by asserting that “[s]imply because Blankenburg et al. states that polymers containing carboxylate groups have become increasingly important does not mean that Blankenburg et al. is teaching that vinyl lactam polymers have become obsolete or even less important.” *Office Action dated February 8, 2005*, at 7.

Whether vinyl lactam polymers are “obsolete or even less important” is irrelevant to a finding of obviousness in the present situation. The issue is whether the prior art teach away from their use. The answer to this question is unequivocally yes, as vinyl lactam polymers are part of the art that the teaching of Blankenburg is seeking to avoid. Accordingly, one of ordinary skill in the art would not have been motivated to use those same polymers in combination with Blankenburg. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must also be considered. *See Bausch & Lomb, Inc. v. Barnes Hind/Hydrocurve, Inc.*, 796 F.2d 443 (Fed. Cir. 1986). “A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994).

In response to the above arguments, the “Examiner does not agree that a person of ordinary skill in the art, upon reading the reference, would be discouraged from combining the vinylpyrrolidone/vinyl acetate/vinyl proprionate copolymer of F[i]rstenberg et al. with the polymers of Blankenburg et al. to arrive at a hair setting composition.” Final Office Action at 3.

Applicant respectfully asserts that the Examiner has turned the standard for finding prima facie obviousness on its head. The standard is not satisfied merely by stating that an artisan would not be discouraged from combining certain elements. Rather, the standard is for the Examiner to show that the references provide some motivation for a particular combination of references. In order to support a rejection under 35 U.S.C. § 103, "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would [actively] select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998) (emphasis added). The Examiner cannot pick and choose from a reference only the teachings that suit his purpose.

Thus, the Examiner has not and cannot show that there is a suggestion or teaching in the combined references that would have motivated a person of ordinary skill in the art to subsequently combine the disclosure of Firstenberg, which does not teach vinyl lactam polymers in combination with another film-forming polymer, and Blankenburg, clearly teaching an admitted alternative to vinyl lactam copolymers. There is simply no motivation between the two references to make such a selection.

In addition, the Examiner's contention that Blankenburg and Firstenberg "both teach hair care fixative compositions in the for[m] of sprays," does not provide a motivation for modification. Office Action dated Feb. 8, 2005, at 4. The Examiner continues to attempt to support his conclusion by stating it "is obvious to combine two compositions taught by the prior art to be individually useful for the same purpose to

form a third composition to be used for that very same purpose.” *Id.* at 4-5 (citing *In re Kerkhoven*, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980)).

Applicant maintains that *Kerkhoven* is not applicable to the present case. In *Kerkhoven*, the claims at issue were directed to a process for forming a detergent, comprising forming two aqueous slurries, where one slurry was predominantly an anionic detergent and the other was primarily a nonionic detergent, independently or simultaneously drying the slurries, and mixing the resulting products. See *Kerkhoven*, 626 F.2d at 847, 205 USPQ at 1070. It was acknowledged that prior art detergents comprised a mixture of anionic fatty acid soaps, anionic detergents, and nonionic detergents. *Kerkhoven*, 626 F.2d at 848, 205 USPQ at 1071. To make the known detergents, all of the ingredients were combined together in one slurry and then spray dried. *Id.* Therefore, the court agreed with the examiner’s conclusion that the claims at issue required “**no more than the mixing together**” of two conventional detergents to make a third detergent composition set forth “prima facie obvious subject matter.” *Kerkhoven*, 626 F.2d at 849, 205 USPQ at 1071 (emphasis added).

There are several key differences between the claimed invention and the invention at issue in *Kerkhoven*. Most notably, the end product in *Kerkhoven* was the same as the two combined ingredients: a detergent. In the claimed invention, the claimed elements are combined to create a solution that can be used to style hair. Moreover, a spray form is not required in the claimed invention. See as-filed specification at page 15, lines 9-14. How individual constituents react to form an end product is not akin to *Kerkhoven* and does not support the Examiner’s conclusion of obviousness. This position is supported by the fact that the literal combination of

Blankenburg and Firstenberg would not give rise to the claimed invention. Thus, the Examiner's application of *Kerkhoven* is inapposite to the present case.

Thus, for at least the foregoing reasons, this rejection is in error and Applicant respectfully requests its withdrawal.

CONCLUSION

In view of the foregoing amendment and remarks, Applicant requests reconsideration of the application, and the timely allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, he is respectfully urged to contact Applicant's undersigned counsel at 202-408-4368.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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